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Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BioSpace International, Inc.

Serial No. 75924406

Mark Harrison of Venable, Baetjer and Howard, LLP for
BioSpace International, Inc.

Linda A. Powell, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney)

Before Simms, Hairston and Bottorff, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

On February 22, 2000, applicant filed the above-
captioned application, by which it seeks registration on
the Principal Register of the mark DYNAMICALLY CONTROLLED
CRYSTALLIZATION SYSTEM for Class 42 services recited in the
application, as amended, as follows:

Scientific research in the field of protein
crystallization, growth and structures, namely,
growing crystals of proteins, DNA and RNA,

determining the macromolecular structure of crystals, crystal diffractions, crystal topography, and crystal micro examination; growing crystals employing the earth's gravitational field, microgravity, levitational techniques, using gradients, artificial intelligence and other novel crystallization. Scientific research in the field of cell growth studies.

The application was filed as an intent-to-use application under Trademark Act Section 1(b), 15 U.S.C. §1051(b). After initial examination, publication of the mark for opposition, and issuance of a Notice of Allowance, applicant filed a Statement of Use, in which it alleged March 1998 as the date of first use of the mark anywhere and the date of first use of the mark in commerce. During initial examination, applicant voluntarily disclaimed the exclusive right to use CONTROLLED CRYSTALLIZATION SYSTEM apart from the mark as shown.¹

¹ We note that the substitute specimens applicant submitted during examination of the Statement of Use appear to belie applicant's contention, made during initial examination of the application, that the wording DYNAMICALLY CONTROLLED has no descriptive significance as applied to the services. For example, the specimen states that "BioSpace International, Inc. (BSI) is dedicated to producing innovative, state-of-the-art technology, products and services which allow precise, dynamic control of protein crystallization on Earth and in Space." (Emphasis added.) However, because the Trademark Examining Attorney has not refused registration of applicant's mark on the ground of mere descriptiveness, the issue is not before us in this appeal.

At issue in this appeal is the Trademark Examining Attorney's final refusal of registration on the ground that the matter sought to be registered, as it is used on applicant's specimens, fails to function as a service mark for the recited services, but rather is used only to identify a process, system or method used by applicant in connection with the recited services. Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051, 1052, 1053 and 1127.

Applicant and the Trademark Examining Attorney have filed main appeal briefs. Applicant did not file a reply brief, and did not request an oral hearing. We affirm the refusal to register.

The Trademark Act provides for registration of a service mark which has been used in commerce. Trademark Act Sections 1(a)(1) and 3, 15 U.S.C. §§1051(a)(1) and 1053. The Act defines a "service mark" as a mark which is used "to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown," and further provides that a service mark is "use[d] in commerce" "when it is used or displayed in the sale or advertising of services and the

services are rendered in commerce..." Trademark Act Section 45, 15 U.S.C. §1127.

It is settled that a designation which is used merely to identify a process, method or system does not function as a service mark. As the predecessor to our primary reviewing court has stated:

The requirement that a mark must be 'used in the sale or advertising of services' to be registered as a service mark is clear and specific. We think it is not met by evidence which only shows use of the mark as the name of a *process* and that the company is in the business of rendering services generally, even though the advertising of the services appears in the same brochure in which the name of the process is used. The minimum requirement is some direct association between the offer of *services* and the mark sought to be registered therefor. [Emphasis in original.]

In re Universal Oil Products Company, 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973). See also *In re Hughes Aircraft Co.*, 222 USPQ 263 (TTAB 1984); *In re Vsesoyuzny Ordena Trudovogo Krasnogo Anameni Nauchnoissledovatel'sky Gorno-Metallurgichesky Institut Tsvetnykh Mettalov "Vnitsvetmet"*, 219 USPQ 69 (TTAB 1983); *Liqwacon Corporation v. Browning-Ferris Industries, Inc.*, 203 USPQ 305 (TTAB 1979); *In re J.F. Pritchard and Company and Kobe Steel, Ltd.*, 201 USPQ 951 (TTAB 1979); *In re Produits Chimiques Ugine Kuhlmann Societe Anonyme*, 190 USPQ 305 (TTAB 1976); and *Ex parte*

Phillips Petroleum Company, 100 USPQ 25 (Comm'r Pats. 1953). However, "while a term used merely to identify a process does not perform the function of a service mark, a term used to identify both a process and the services rendered in connection therewith constitutes a service mark within the meaning of the Trademark Act." *In re Hughes Aircraft Co.*, *supra*, 222 USPQ at 264; see also *In re Produits Chimiques Ugine Kuhlmann Societe Anonyme*, *supra*, 190 USPQ at 306 (TTAB 1976) and cases cited therein. Moreover,

[t]he question of whether or not a term used as the name of a process also functions as a service mark must be determined by examining the specimens of record along with any other material made of record by applicant during the prosecution of [the application]. This will allow a determination of the commercial impression created by the term as used by applicant.

In re Hughes Aircraft Co., *supra*, 222 USPQ at 264. See also *Liqwacon Corporation v. Browning-Ferris Industries*, *supra*, 203 USPQ at 318 (TTAB 1979).

In the present case, the specimens submitted by applicant consist of various brochures advertising applicant's services. We have carefully reviewed these specimens, and we conclude that the designation applicant seeks to register, DYNAMICALLY CONTROLLED CRYSTALLIZATION

SYSTEM, clearly is used by applicant and would be understood by purchasers solely as the name of the method or system that applicant uses in rendering the services recited in the application. Indeed, the brochures repeatedly and expressly state that applicant's DYNAMICALLY CONTROLLED CRYSTALLIZATION SYSTEM is a "system," "method," "process" or "technology." For example (in these excerpts, the bold type is applicant's emphasis, and the underlining is the Board's emphasis):

BSI has developed a new system - the **Dynamically Controlled Crystallization System - DCCS™** - (patent pending) which allows computer controlled variations of crystallization conditions...

A compact, sealed microgravity unit has been developed for use in Space to determine the effects of microgravity on the process for NASA.

The **Dynamically Controlled Crystallization System™** has clear potential as a system for automated screening of crystallization conditions over a wide range of variables using minimal amounts of sample.

BSI believes that its system will improve the quality of crystallized proteins and provide researchers far greater precision in the protein crystal growth process.

Solubility Profiles of the 3 Predominant
Methods Used in Protein Crystallography

- Microbatch is used in automated robotic systems
- Vapor Diffusion is the most widely used method
- The Dynamically Controlled Crystallization System™ using dialysis is the method used by BSI Proteomics

BSI Proteomics DCCS™ Technology

- Computer controlled dialysis
- Permits predetermined control of the rate at which the protein approaches the nucleation cloud point
- Variable volume requirements
 - 2ul to 40 ul
- Equilibrates within 60-minutes or as long as 3-weeks (as needed)

It is apparent that DYNAMICALLY CONTROLLED CRYSTALLIZATION SYSTEM is not used in these brochures to identify applicant's protein crystallization services and to distinguish them from the protein crystallization services of others, but rather is used to identify applicant's method of protein crystallization and to distinguish that method from alternative methods used by others.² In the brochures, the designations which are used by applicant (and which would be perceived by purchasers)

² In the brochures, applicant's use of the "TM" symbol in conjunction with the designation it seeks to register does not aid applicant's contention that the designation is used as a service mark for the recited services. This would be so even if applicant had used the symbol "SM" rather than "TM." See *In re Remington Products Inc.*, 3 USPQ2d 1714 (TTAB 1987); *In re Anchor Hocking Corp.*, 223 USPQ 85 (TTAB 1984); *In re Minnetonka, Inc.*, 212 USPQ 772 (TTAB 1981).

as indicators of the source of the services, per se, are BioSpace International, Inc., BioSpace, BSI, and BSI Proteomics, as is apparent from the following excerpts (emphasis added):

BioSpace International, Inc. (BSI) is dedicated to producing innovative, state-of-the-art technology, products and services which allow precise, dynamic control of protein crystallization on Earth and in Space. **BSI's** Dynamically Controlled Crystallization System - DCCS™- reduces the time and resources traditionally needed for protein crystallization, and will dramatically improve the crystallization of proteins that have been difficult or impossible to crystallize in the past.

Mission Statement: **BSI Proteomics is paving the way** for the discovery of new drugs with DCCS™, and is dedicated to the production of innovative state-of-the-art technologies, products, and services, which allow precise, dynamic control of protein crystallization for structure elucidation leading to new drug discoveries.

BioSpace International, Inc. is a biotechnology company which is focusing on technologies related to protein crystal growth in the laboratory and in microgravity environment. **BSI has developed a new system** - the Dynamically Controlled Crystallization System - DCCS™ - (patent pending) which allows computer controlled variations of crystallization conditions...

BSI believes that its system will improve the quality of crystallized proteins and provide researchers far greater precision in the protein crystal growth process.

Four of **BioSpace's DCCS™ commercial systems** will be flown on the Space Shuttle in the fall of 1998.

BSI is currently interested in evaluating DCCS™ with a variety of proteins and conditions to determine the breadth of applications possible and future research needs in this area.

Examples of Proteins Crystallized **by BSI Proteomics...**

The Dynamically Controlled Crystallization System™ using dialysis is the method used **by BSI Proteomics**

Applicant has not pointed to a single instance in which DYNAMICALLY CONTROLLED CRYSTALLIZATION SYSTEM is used in these brochures as a mark identifying applicant's services, per se, and distinguishing them from the services of others, and we can find no such usage ourselves. We therefore conclude that the commercial impression created by DYNAMICALLY CONTROLLED CRYSTALLIZATION SYSTEM, as that designation is used in applicant's specimens, is solely that it is the name of the proprietary method or process that applicant uses in rendering the recited services. The specimens fail to show the requisite "direct association between the offer of *services* and the mark sought to be registered therefor." *In re Universal Oil Products Company, supra*, 177 USPQ at 457. Accordingly, the designation fails to function as a service mark for the

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recited services. Applicant's conclusory argument to the contrary is not persuasive.

Decision: The refusal to register is affirmed.